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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/781.578

02/17/2004

Michael Baeuerle

10191/3521

3095

26646

7590

08/31/2006

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NEW YORK, NY 10004

EXAMINER

JENKINS, JERMAINE L

ART UNIT

PAPER NUMBER

2855

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/781,578	BAEUERLE, MICHAEL	
	Examiner	Art Unit	
	Jermaine Jenkins	2855	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06122006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed toward a method for operating an internal combustion engine by measuring an actual pressure ratio across the compressor for diagnosing compression. The comparing of the measured actual pressure ratio to a modeled actual pressure ratio and are understood to be abstract. The collection of determining steps that comprise the method is not "a practical application of an abstract idea" as required by State Street. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373-74, 47 USPQ2d at 1596 (Fed. Cir. 1998). Neither does the claimed invention produce a "useful, concrete, and tangible result" as required by State Street. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The analysis focuses on claims 1, 7, 8, 13, 14 & 17-19; the dependent claims only add details on how the abstract parameters are determined, and have no separately statutory features.

The claims are non-transformatory. The claims do not recite any physically transformative operations either in the determination of the parameters or in their use. For instance, the claims do not specify that the comparison of the first and second ratio dictate an actual output. Neither do the claims specify with what device or structure the parameters are determined. For instance, the determination of "comparing the measured actual pressure ratio to a modeled actual pressure ratio" can be done by (i) software package run by an onboard or external computer (ii) physically sensing/measuring parameters of the tire of a vehicle (iii) or by a visual examination of a tire. The claims lack a description of the process by which the parameters are determined or a practical application of the determined parameters.

The claims are not concrete. The claims leave open the question of what is "an error as a function of a result of the comparing". The method of detecting an error as a function of a result of the comparing, as set forth by claims, is a compilation of data, independent of physical form. The specification provides a description of a process that only manipulates abstracts ideas or concepts (wherein comparison of the measured actual pressure ratio to a modeled actual pressure ratio are read as abstract ideas and mathematical concepts). The invention set forth in the claims does not produce a tangible result.

Though the above analysis, it can be seen that merely "detecting" would not appear to be sufficient to constitute a tangible result, since the outcome of the

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“detecting” step has not been used in a disclosed practical application nor made available in such a manner that it’s usefulness in a disclosed practical application can be realized. Furthermore, the steps of “detecting” do not involve any physical transformation of data, or produce any physically perceptible result outside of the abstraction of individual thought. For the abovementioned reasons, claims 1-19 are not statutory under 35 USC 101.

Conclusion

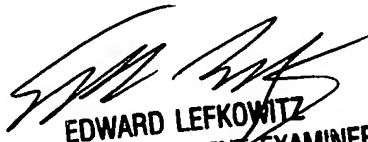
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermaine Jenkins whose telephone number is 571-272-2179. The examiner can normally be reached on Monday-Friday 9am-530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Edward Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A.U. 2855


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